

REMARKS/ARGUMENTS

I. General Remarks

Please consider the application in view of the following remarks. Applicants thank the Examiner for her careful consideration of this application and the references cited by Applicants in this application.

As set forth above, Applicants have requested continued examination in this application, in accordance with 37 C.F.R. § 1.114. Moreover, Applicants respectfully request that the amendments presented herein be entered and further request consideration of the claims in light of the amendments and remarks made herein.

II. Disposition of the Claims

At the time of the Final Office Action, claims 18-32 and 34-77 were pending. Claims 1-17 and 33 were canceled in a previous response. Claims 20-24, 27, 30, 37-41, 44, 47, 50-64, and 67 were withdrawn from consideration. Claims 18, 19, 25, 26, 28, 29, 31, 32, 34-36, 42, 43, 45, 46, 48, 49, 65, 66, and 68-77 stood rejected. Claims 18, 35, 50, 66-68, and 70 have been amended herein. Claim 24 has been canceled. Applicants respectfully request that the above amendments be entered and further request reconsideration in light of the amendments and remarks contained herein.

III. Remarks Regarding Rejections Under 35 U.S.C. § 103(a)

A. Claims 35, 36, 42, 45, 46, 48, 49, 68-73, 75, and 76

At the time of the Final Office Action, claims 35, 36, 42, 45, 46, 48, 49, 68-73, 75, and 76 stood rejected under 35 U.S.C. § 103(as) as being unpatentable over U.S. Patent Publication No. 2002/0048676 by McDaniel *et al.* (hereinafter “*McDaniel*”) in view of U.S. Patent No. 5,585,524 issued to Sielcken *et al.* (hereinafter “*Sielcken*”). Applicants respectfully disagree with this rejection.

In order for a reference or combination of references to form the basis for a rejection under § 103(a), a *prima facie* case of obviousness must be established. Obviousness is determined by construing the scope of the prior art, identifying the differences between the claims and the prior art, determining the level of skill in the pertinent art at the time of the invention, and considering objective evidence present in the application indicating obviousness or nonobviousness. *Graham v. John Deere*, 383 U.S. 1, 17 (1966). Applicants respectfully submit that due to the differences between the claims as currently amended and the cited

references the Examiner has not established a *prima facie* case of obviousness, in that the combination of *McDaniel* and *Sielcken* does not teach each and every recitation of the present claims.

In particular, the combination of *McDaniel* and *Sielcken* fails to teach or suggest “providing a first flowing stream comprising at least one coated particulate, wherein the coated particulate comprises a particulate coated with a coating material and wherein the particulate has a size in the range of from 4 to 100 U.S. mesh; providing a second flowing stream comprising at least one density reducing material; combining the first flowing stream and the second flowing stream to form a third flowing stream” and “allowing the density reducing material to adhere to a surface of the coated particulate to create at least one reduced-density, coated particulate,” as required by independent claims 35 and 68. In contrast, *McDaniel* fails to disclose coating a particulate with a size in the range of 4 to 100 U.S. mesh with a coating material and then adhering a density reducing material to its surface. See *McDaniel*, entire specification.

Moreover, *Sielcken* fails to obviate the deficiencies of *McDaniel*. Rather, the Examiner merely relied on *Sielcken* for its alleged disclosure that “if components can be mixed in a batchwise process, they may be mixed in a stirred tank reactor or a tubular reactor.” (Final Office Action at 5.) Applicants note that the portions of *Sielcken* cited by the Examiner do not teach that any process that can be performed batchwise may also be performed continuously, rather *Sielcken*’s disclosure demonstrates that an aldehyde may be formed in a batchwise process and a continuous process. See *Sielcken*, col. 5, lines 61-65. *Sielcken* provides no motivation to modify a method of adhering a density reducing material to a coated particulate so that the method is performed on-the-fly, much less that the method is performed in the manner described in Applicants’ claims.

Furthermore, Applicants respectfully submit that each rejection using *Sielcken* as a reference is improper because *Sielcken* is neither in the field of Applicants’ endeavor nor is *Sielcken* reasonably pertinent to the particular problem with which Applicants are concerned - that is, *Sielcken* is non-analogous art. In order to rely on a reference as a basis for rejection under § 103(a) of an Applicant’s invention, the reference must either be in the field of Applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. See MPEP § 2141.01(a).

The general field of endeavor of Applicants’ invention relates to methods for creating reduced-density, coated particulates and methods for using such particulates in

subterranean operations. *See* Specification, abstract. In contrast, *Sielcken* is related to a method for the preparation of an aldehyde in a process in which cobalt is being recycled. *Sielcken*, abstract. As such, *Sielcken* is not in the field of Applicants' endeavor.

Additionally, Applicants respectfully submit that *Sielcken* is not reasonably pertinent to the particular problem with which Applicants were concerned. In order for a reference to be reasonably pertinent, "it must be one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." *See* MPEP § 2141.01(a). The subject matter of *Sielcken* deals with chemical reactions to produce an aldehyde. *See* *Sielcken*, entire specification. On the other hand, Applicants' invention is concerned with adhering density reducing materials to coated particulates and their use in a subterranean formation. *See* entire Specification. Accordingly, Applicants respectfully submit that the compositions and methods disclosed in *Sielcken* would not logically have been considered when considering compositions and methods related to reduced-density, coated particulates, as methods that are useful creating aldehydes would not have commended themselves to the attention of an inventor concerned with the formation of reduced-density, coated particulates. Therefore, *Sielcken* is not analogous art, and the rejections based on *Sielcken* are improper.

For at least these reasons, Applicants respectfully assert that independent claim 35 and 68 and their dependent claims are not rendered obvious by the combination of *McDaniel* and *Sielcken*. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 35, 36, 42, 45, 46, 48, 49, 68-73, 75, and 76.

B. Claims 18, 19, 25, 28, 29, 31, 32, 34, 65, and 66

At the time of the Final Office Action, claims 18, 19, 25, 28, 29, 31, 32, 34, 65, and 66 stood rejected under 35 U.S.C. § 103(as) as being unpatentable over *McDaniel*, in view of *Sielcken*, in further view of U.S. Patent No. 4,969,523 issued to Martin *et al.* (hereinafter "*Martin*") Applicants respectfully disagree with this rejection.

As discussed above in Section III(A), *McDaniel* and *Sielcken* fail to teach or suggest "providing a first flowing stream comprising at least one coated particulate, wherein the coated particulate comprises a particulate coated with a coating material and wherein the particulate has a size in the range of from 4 to 100 U.S. mesh; providing a second flowing stream comprising at least one density reducing material; combining the first flowing stream and the second flowing stream to form a third flowing stream" and "allowing the density reducing

material to adhere to a surface of the coated particulate to create at least one reduced-density, coated particulate,” as required by independent claims 18 and 35. Furthermore, as discussed above in Section III(A), rejections based upon *Sielcken* are improper as *Sielcken* is non-analogous art. Still further, *Martin* fails to obviate the deficiencies of *McDaniel* and *Sielcken*. Rather, the Examiner merely relied on *Martin* for its alleged disclosure of “low density SVDB as the density reducing material.” (Final Office Action at 7.)

For at least these reasons, Applicants respectfully assert that independent claims 18 and 35 and their dependent claims are not rendered obvious by the combination of *McDaniel*, *Sielcken*, and *Martin*. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 18, 19, 25, 28, 29, 31, 32, 34, 65, and 66.

C. Claims 35, 36, 45, 49, 68-70, 72, and 75

At the time of the Final Office Action, claims 35, 36, 45, 49, 68-70, 72, and 75 stood rejected under 35 U.S.C. § 103(as) as being unpatentable over U.S. Patent No. 4,493,875 issued to Beck *et al.* (hereinafter “*Beck*”) in view *Sielcken*. Applicants respectfully disagree with this rejection.

In particular, the combination of *Beck* and *Sielcken* fails to teach or suggest “providing a first flowing stream comprising at least one coated particulate, wherein the coated particulate comprises a particulate coated with a coating material and wherein the particulate has a size in the range of from 4 to 100 U.S. mesh; providing a second flowing stream comprising at least one density reducing material; combining the first flowing stream and the second flowing stream to form a third flowing stream” and “allowing the density reducing material to adhere to a surface of the coated particulate to create at least one reduced-density, coated particulate,” as required by independent claims 35 and 68.

Moreover, *Sielcken* fails to obviate the deficiencies of *Beck*. Rather, the Examiner merely relied on *Sielcken* for its alleged disclosure that “if components can be mixed in a batchwise process, they may be mixed in a stirred tank reactor or a tubular reactor.” (Final Office Action at 5.) As Applicants noted above in Section III(A), *Sielcken* provides no motivation to modify a method of adhering a density reducing material to a coated particulate so that the method is performed on-the-fly, much less that the method is performed in the manner described in Applicants’ claims. Furthermore, as also discussed above in Section III(A), rejections based upon *Sielcken* are improper as *Sielcken* is non-analogous art.

For at least these reasons, Applicants respectfully assert that independent claims 35 and 68 and their dependent claims are not rendered obvious by the combination of *Beck* and *Sielcken*. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 35, 36, 45, 49, 68-70, 72, and 75.

IV. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art.

SUMMARY AND PETITION FOR TWO MONTH EXTENSION OF TIME

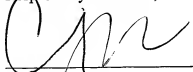
In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants hereby petition for a two-month extension of time to file this response under 37 C.F.R. § 1.136(a), extending the deadline from October 12, 2008 to December 12, 2008. Accordingly, Applicants have authorized via the Office's electronic filing system the Commissioner to debit the Deposit Account of Baker Botts L.L.P., Deposit Account No. 02-0383, Order Number 063718.0178, in the amount of \$490.00 under 37 C.F.R. § 1.17(a)(2) for the two-month extension of time, extending the period to reply up to and including December 12, 2008.

Applicants have also authorized the Commissioner via the Office's electronic filing system to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.0178, in the amount of \$810.00 for the RCE fee under 37 C.F.R. § 1.17(e). Should the Commissioner deem that any additional fees are due, the Commissioner is authorized to debit

Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.0178, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Jordan', is written over a horizontal line.

Carey C. Jordan
Reg. No. 47646
BAKER BOTTS, L.L.P.
910 Louisiana Street
Houston, Texas 77002-4995
Telephone: 713.229.1233
Facsimile: 713.229.7833
Email: Carey.Jordan@bakerbotts.com

Date: December 3, 2008